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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/573,561	12/15/95	REASONER	M 65,748-002-T

HAROLD W MILTON JR
HOWARD & HOWARD ATTORNEYS
1400 NORTH WOODWARD AVENUE
SUITE 101
BLOOMFIELD HILLS MI 48304

35M1/1202

EXAMINER

LUONG, V

ART UNIT PAPER NUMBER

3502

DATE MAILED:

12/02/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

EXHIBIT # 1
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OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 3/8/96
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 (three) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.36(a).

Disposition of Claims

- ☒ Claim(s) 1-16 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-16 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. Claims 1-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether:

(a) a confusing variety of terms such as: (1) "a motion transmitting core element" and "a flexible motion transmitting core element" in claim 1; (2) "first and second conduit sections" in claim 1 and "first and second telescoping members" in claim 2; and (3) "an abutment" in claim 3 and "a locking member" in claim 5 refer to the same or different structures. See MPEP 608.01(o);

(b) applicant claims an apparatus (a motion transmitting core element) *per se*, or a process of use. See, e.g., "so that" clause in claim 3;

(c) applicant claims an apparatus (a motion transmitting core element) *per se*, or a process of assembly. See, e.g., claims 2, 3 and 8; and

(d) the recitation "characterized by" signifies "comprising" or "consisting of".

The term such as "movable" in claim 6 is indefinite in the sense that things which may be done are not required to be done, e.g., the retainer is movable, but not required structurally to be moved.

2. The following is a quotation of the appropriate paragraphs

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of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7, as best understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by Dickirson (U.S. Patent No. 5,039,138).

Assuming *arguendo* that applicant claims an apparatus *per se*:

Regarding claim 1, Dickirson teaches an assembly comprising first and second conduit sections 22 and 26, a core element 24, 28, adjustment components 30 interconnecting the conduit sections 22 and 26, and a spring 42, 242 interacting with components 30. *Ibid.*, line 4 *et seq.* of column 5, claims 1-16, and Figs. 6-10B.

Applicant's claim 1 is "fully met" by Dickirson. The functional statement cannot serve to distinguish claims, which are not process claims, from reference since it does not define any structure. *In re Mason*, 114 USPQ 127 (CCPA 1957).

Regarding claim 2, the components 30 include first and second telescoping members 34 and 36, and a retainer 38, 238 for retaining the spring 42, 242.

Regarding claim 3, see an abutment 220.

Regarding claim 4, see female and male members 34 and 36.

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Regarding claim 5, see adjustment teeth 58 (Fig. 6) along the male member 36 and a locking member 220, 230 supported by the female member 34 for engaging the teeth 58 (Fig. 9).

Regarding claim 6, the locking member 220, 230 includes a tunnel (unnumbered in, e.g., Fig. 6) therethrough, the retainer 38, 238 is movable therethrough (Fig. 9). See *In re Mason*, *supra*.

Regarding claim 7, see complementary keyways defined by interfitting shapes (squared cross sections) of the end fitting 238 and 240 in Fig. 6. *Ibid.*, line 65 et seq. of column 4.

4. Claims 8-16 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112 and to include all of the limitations of the base claim and any intervening claims.

5. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Reasoner (Fig. 5), Cunningham (telescopic members 19 and 22), Perry (male and female members 50 and 52), Ruhlman (telescopic members 20 and 58 in Fig. 6), Simon (Fig. 1), Spease et al. (Fig. 14), Boike (male and female members 20 and 18), LeVahn (Fig. 7), and Jaksic (spring 23) are cited.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Tuesday-Friday from 7:30 A.M. to 6:00 P.M. Eastern Standard Time. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Charles Marmor, can be reached on (703) 308-2168. The fax phone number for this Group is (703) 305-3598.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

Luong

November 26, 1996


VINH T. LUONG
PRIMARY EXAMINER
ART UNIT 352